REMARKS:

Claims 1-27 are currently pending in the application. Claims 1, 3, 4, 6, 7, 10, 14, 16, 17, 19, 20, 23, and 27 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,329,619 to Page et al. ("Page"). Claims 2, 13, 15, and 26 stand rejected under 35 U.S.C. § 103(a) over Page in view of U.S. Patent Application Publication No. 2002/0023037 A1 to White, Jr. ("White"). Claims 5 and 18 stand rejected under 35 U.S.C. § 103(a) over Page in view of U.S. Patent Application Publication No. 2003/0121000 A1 to Cooper et al. ("Cooper"). Claims 8 and 21 stand rejected under 35 U.S.C. § 103(a) over Page in view of U.S. Patent No. 6,381,579 to Gervais et al. ("Gervais"). Claims 9, 11, 12, 22, 24, and 25 stand rejected under 35 U.S.C. § 103(a) over Page in view of U.S. Patent No. 5,926,636 to Lam et al. ("Lam").

By this Amendment, Applicants have amended independent claim 1 to correct certain typographical errors and to more particularly point out and distinctly claim the Applicants invention. No new matter has been added.

ABSTRACT OBJECTION UNDER MPEP § 608.01(b):

The Applicants thank the Examiner for withdrawing the objection to the abstract.

CLAIM OBJECTION:

The Applicants thank the Examiner for withdrawing the objection to claims 5 and 18.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102(b):

Claims 1, 3, 4, 6, 7, 10, 14, 16, 17, 19, 20, 23, and 27 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,329,619 to Page et al. ("Page").

The Office Action alleges that Page discloses a computer-implemented system and method comprising a request broker and an application server. The Applicants have reviewed Page in detail, particularly looking for the computer-implemented system and method comprising a request broker and an application server, relied upon by the Examiner. However, Page fails to disclose each and every limitation recited by claims 1, 3, 4, 6, 7, 10, 14, 16, 17, 19, 20, 23, and 27. Thus, Applicants respectfully submit that claims 1, 3, 4, 6, 7, 10, 14, 16, 17, 19, 20, 23, and 27 patentably distinguish over Page.

For example, with respect to amended independent claim 1, this claim recites:

A computer-implemented system, comprising:

a request broker, implemented as a component within a hub system, operable to:

receive a network API request component from a client, located remote from the hub system, the network API request component comprising a description of a system API method to be called and one or more parameters to be used in executing the system API method, the parameters having one of a plurality of acceptable native formats;

determine the native format of the parameters;

communicate the parameters in the native format to a selected one of a plurality of translators for translation of the parameters from the native format to an internal format, each translator being associated with a different native format; and

communicate the parameters in the internal format to an application server to enable execution of the system API method according to the parameters; and

the application server system, operable to receive the parameters from the request broker in the internal format, generate a return value reflecting execution of the system API method according to the parameters, and communicate the return value to the request broker in the internal format; and

the request broker further operable to receive the return value from the application server system in the internal format, communicate the return

<u>value in the internal format to the selected translator for translation of the return value from the internal format to the native format, generate a network API reply component that comprises the description of the system API method that was called and the return value in the native format, and communicate the network API reply component to the client</u>. (Emphasis Added).

Independent claims 14 and 27 recite similar limitations. Page fails to disclose each and every limitation of independent claims 1, 14, and 27. The Applicants respectfully traverse the Examiners assertions regarding the subject matter disclosed in Page.

The Applicants respectfully submit that Page has nothing to do with amended independent claim 1 limitations regarding a computer-implemented system and method comprising a request broker and an application server. Rather Page discloses a service broker that manages service requests received from clients and servers. (Abstract). Page merely discloses a service request manager. Page does not disclose, teach, or suggest a request broker implemented as a component within a hub system operable to: (1) receive a network application program interface component from a client located remote from the hub system and comprising a description of a system application program interface method having a plurality of acceptable native formats; (2) determine and communicate the native format of the parameters to a translator for translation of the parameters from the native format to an internal format; or (3) communicate the parameters in the internal format from the request broker to an application server system to enable execution of the system application program interface method according to the parameters. Thus, Page cannot provide a request broker implemented as a component within a hub system, since Page does not receive a network application program interface component comprising a description of a system application program interface method, determine and communicate the native format of the parameters to a translator for translation of the native format into an internal format, or communicate the parameters in the internal format from the request broker to an application server system.

The Applicants respectfully submit that the allegation in the present Office Action that Page discloses all of the claimed features is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how Page is considered to

anticipate all of the limitations in independent claim 1. A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference. MPEP § 2131. Applicants respectfully point out that "it is incumbent upon the [E]xaminer to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." Ex parte Levy, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). The Applicants respectfully submit that the Office Action has failed to establish a *prima facie* case of anticipation in independent claim 1 under 35 U.S.C. § 102 with respect to Page because Page fails to identically disclose each and every element of the Applicants claimed invention, arranged as they are in Applicants claim.

The Applicants further submit that the Office Action acknowledges, and the Applicants agree, that Page fails to disclose the emphasized limitations in independent claim 1. Specifically the Examiner acknowledges that Page fails to teach a request broker receiving a network application program interface component from a client, located remote from the hub system. (2 August 2005 Office Action, Examiner's Response, Page 3). However, the Examiner asserts that cited text of Page is the equivalent to Applicants independent claim 1 limitations. The Applicants respectfully traverse the Examiner's assertions regarding any purported equivalent features of Page. The Applicants direct the Examiners attention to the cited portions of Page, relied upon by the Examiner:

> Service Broker 14 manages requests by any participant for services provided by some other participant. Service broker 14 provides transparent service links between the clients and servers and allows users to tie together the heterogeneous environment of Figure 2. (Column 4, Line 37-41).

Although, Page discloses a service broker that manages requests by participants for services, Page fails to disclose a request broker implemented as a component within a hub system. Page does not disclose, suggest, or even hint at a request broker or even a service broker implemented within a hub system. The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight to reach this conclusion and reconstructive hindsight is improper under 35 U.S.C. § 102. The Applicants further submit that Page does not teach, suggest, or even hint at

the management of the service broker does anything more than simply receive requests from a participant. Thus, the Office Action has failed to establish a *prima facie* case of anticipation in independent claim 1 under 35 U.S.C. § 102 with respect to Page because Page fails to identically disclose each and every element of independent claim 1 arranged as they are in Applicants claims.

The Applicants further submit that the Office Action acknowledges, and the Applicants agree, that Page fails to disclose the emphasized limitations in independent claim 1. Specifically the Examiner acknowledges that Brodsky fails to teach a network application program interface component from a client located remote from the hub system and comprising a description of a system application program interface method having a plurality of acceptable native formats. (2 August 2005 Office Action, Examiner's Response, Page 3). However, the Examiner asserts that cited text of Page is the equivalent to Applicants independent claim 1 limitations. The Applicants respectfully traverse the Examiner's assertions regarding any purported equivalent features of Page. The Applicants direct the Examiners attention to the cited portions of Page, relied upon by the Examiner:

> The service broker works directly with the LAPI by accepting and transmitting information directly in FSP control blocks. (Column 6, Lines 64-66).
> Accordingly, as shown in FIG 3A, each participant can communicate via an HAPI. (Column 7, Lines 10-11).

The Applicants respectfully submit that the cited text of Page has nothing to do with a network application program interface component from a client located remote from the hub system and comprising a description of a system application program interface method having a plurality of acceptable native formats. Rather Page discloses a service broker that accepts and transmits information directly in FSP control blocks. Page fails to disclose a network application program interface component located remote from the hub system. Furthermore, Page does not disclose, suggest, or even hint at a network application program interface component comprising a description or any other information relating to a system application program interface method having a plurality or even one of

acceptable native formats. The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight to reach this conclusion and reconstructive hindsight is improper under 35 U.S.C. § 102. Thus, the Office Action has failed to establish a *prima facie* case of anticipation in independent claim 1 under 35 U.S.C. § 102 with respect to Page because Page fails to identically disclose each and every element of independent claim 1 arranged as they are in Applicants claims.

The Applicants respectfully submit that the purported equivalent features of Page relied on by the Examiner are nowhere disclosed, taught, or suggested in Page. The Examiner asserts that "Page is receiving a network application program interface from participants that are remote from the service broker for service requests since the service broker is implemented within a hub system." (2 August 2005 Office Action, Examiner's Response, Page 3). The Applicants respectfully disagree. The Applicants respectfully submit that the Examiner is using circular logic in reaching the Examiner conclusions and circular logic is improper under 35 U.S.C. § 102. Thus, the Office Action has failed to establish a *prima facie* case of anticipation in independent claim 1 under 35 U.S.C. § 102 with respect to Page because Page fails to identically disclose each and every element of independent claim 1 arranged as they are in Applicants claims.

The Applicants further submit that Page does not disclose determining or communicating the native format of the parameters to a translator for translation of the parameters from the native format to an internal format. The Applicants still further submit that Page does not disclose, teach or suggest communicating the parameters in the internal format from the request broker to an application server system to enable execution of the system application program interface method according to the parameters. Although Page discloses a translation service that <u>may</u> be used for different data formats; it is only contemplated for use provided a suitable translation routine is available, (column 46, lines 59-67), Page does not determine or communicate the native formats or even the different data formats to an internal format within a selected one of a plurality of translators. Thus, Page cannot provide determining or communicating the native format of the parameters to a translator for translation of the parameters from the native format to an internal format or communicating the parameters in the internal format from the request

broker to an application server system to enable execution of the system application program interface method according to the parameters, since Page does not even provide for translation of parameters from a native format to an internal format.

With respect to independent claims 14 and 27 each of these claims includes limitations similar to those discussed above in connection with amended independent claim 1. Therefore, independent claims 14 and 27 are considered patentably distinguishable over Page for at least the reasons discussed above in connection with amended independent claim 1.

With respect to dependent claims 3, 4, 6, 7, 10, 16, 17, 19, 20, and 23; claims 3, 4, 6, 7, and 10 depend from amended independent claim 1, and claims 16, 17, 19, 20, and 23 depend from independent claim 14. As mentioned above, each of independent claims 1, 14, and 27 is considered patentably distinguishable over Page. Thus, dependent claims 3, 4, 6, 7, 10, 16, 17, 19, 20, and 23 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for at least the reasons set forth herein, the Applicants submit that claims 1, 3, 4, 6, 7, 10, 14, 16, 17, 19, 20, 23, and 27 are not anticipated by Page. The Applicants further submit that claims 1, 3, 4, 6, 7, 10, 14, 16, 17, 19, 20, 23, and 27 are in condition for allowance. Therefore, the Applicants respectfully request that the rejection of claims 1, 3, 4, 6, 7, 10, 14, 16, 17, 19, 20, 23, and 27 under 35 U.S.C. § 102(b) be reconsidered and that claims 1, 3, 4, 6, 7, 10, 14, 16, 17, 19, 20, 23, and 27 be allowed.

Furthermore, for at least the reasons set forth above, the Applicants respectfully request that the Finality of the present Office Action be reconsidered and that the Finality of the present Office Action be withdrawn.

THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. <u>Prior Knowledge</u>: The invention was publicly known in the United States before the patentee invented it.

2. <u>Prior Use</u>: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

3. <u>Prior Publication</u>: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

4. <u>Prior Patent</u>: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.

5. <u>On Sale</u>: The invention was on sale in the United States more than one year before the patentee filed his application.

6. <u>Prior Invention</u>: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. <u>Prior U.S. Patent</u>: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.

2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that

claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.

3.   There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.

4.   There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1.   <u>Prior Knowledge</u>: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2.   <u>Prior Use</u>: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3.   <u>Prior Publication</u>: A patent is invalid if the invention defined by the claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession

of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4.   Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5.   On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6.   Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7.   Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 2, 13, 15, and 26 stand rejected under 35 U.S.C. § 103(a) over Page in view of U.S. Patent Application Publication No. 2002/0023037 A1 to White, Jr. ("White"). Claims 5 and 18 stand rejected under 35 U.S.C. § 103(a) over Page in view of U.S. Patent Application Publication No. 2003/0121000 A1 to Cooper et al. ("Cooper"). Claims 8 and 21 stand rejected under 35 U.S.C. § 103(a) over Page in view of U.S. Patent No. 6,381,579 to Gervais et al. ("Gervais"). Claims 9, 11, 12, 22, 24, and 25 stand rejected under 35 U.S.C. § 103(a) over Page in view of U.S. Patent No. 5,926,636 to Lam et al. ("Lam").

The Applicants respectfully submit that Page or White either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 2, 13, 15, or 26. The Applicants further submit that Page or Cooper either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 5 or 18. The Applicants still further submit that Page or Gervais either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 8 or 21. Furthermore, the Applicants respectfully submit that Page or Lam either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 9, 11, 12, 22, 24, and 25. Thus, the Applicants respectfully traverse the Examiners obvious rejection of claims 2, 5, 8, 9, 11, 12, 13, 15, 18, 21, 22, 24, 25, and 26 under 35 U.S.C. § 103(a) over the proposed combination of Page, White, Cooper, Gervais, and Lam, either individually or in combination.

For example, with respect to dependent claims 2 and 13 these claims recite:

> 2.   The system of Claim 1, wherein:
> the <u>request broker is implemented as a servlet operating at a Secure Hypertext Transport Protocol (HTTPS) web server;</u> and
> the <u>network API request and network API reply components</u> comprise Multi-purpose Internet Mail Extension (MIME) containers communicated over the Internet in HTTPS messages. (Emphasis Added).

> 13.   The system of Claim 1, <u>further comprising a system firewall</u> having a plurality of ports, the system maintaining at least one port of the system firewall open for communication with the client, the client initiating a connection to the system through the at least one open port of the system firewall <u>to communicate the network API request component to the request broker</u>, independent of any port of a client firewall being open for communication with the system. (Emphasis Added).

Dependent claims 15 and 26 recite similar limitations. Page or White either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 2, 13, 15, or 26.

The Applicants respectfully submit that the Office Action acknowledges, and the Applicants agree, that Page fails to disclose the emphasized limitations noted above in

dependent claims 2 and 13. Specifically the Examiner acknowledges that Page fails to teach a request broker implemented as a servlet operating at a Secure Hypertext Transport Protocol (HTTPS) web server and the network API request and network API reply components comprise Multi-purpose Internet Mail Extension (MIME) containers communicated over the Internet in HTTPS messages. The Examiner further acknowledges that Page fails to teach the computer-implemented system of Claim 1 including a system firewall having a plurality of ports, the system maintaining at least one port of the system firewall open for communication with the client, the client initiating a connection to the system through the at least one open port of the system firewall to communicate the network API request component to the request broker, independent of any port of a client firewall being open for communication with the system. (2 August 2005 Office Action, Pages 11-12). However, the Examiner asserts that the cited portions of White disclose the acknowledged shortcomings in Page. The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in White.

The Applicants further submit that White has nothing to do with dependent claims 2 and 13 limitations regarding: (1) a request broker implemented as a servlet operating at a Secure Hypertext Transport Protocol (HTTPS) web server or (2) a computer-implemented system comprising a request broker and an application server maintaining at least one port of a system firewall open for communication with the client to communicate the network application program interface request component to the request broker, independent of any port of a client firewall being open for communication with the system. Rather White discloses a data processing system with a secure hypertext transfer protocol associated with a particular non-secure port, thereby providing a secure port on a data channel. (Abstract). White does not disclose a request broker, implemented as a component within a hub system, operating at a Secure Hypertext Transport Protocol (HTTPS) web server or a client initiating a connection through at least one port of the system firewall to communicate with a request broker, implemented as a component within a hub system. Thus, White cannot provide a request broker implemented as a servlet operating at a Secure Hypertext Transport Protocol web server, since White does not even provide a web server, an

application server, a network application program interface request component or even a network application program interface replay component.

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Page or White, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that it would have been obvious to one having ordinary skill in the art at the time of invention was made to incorporate White into Page's service broker such that an entire https session can take place, mediated by port 80, and thus is permitted to be established and carried out even if the user is located on a system having a firewall that blocks port 443 as taught by white. (2 August 2005 Office Action, Page 12). The Applicants respectfully disagree.

The Applicants further submit that the reasoning relied on by the Examiner for combining the references are nowhere disclosed, taught, or suggested in Page or White either individually or in combination. The Applicants respectfully request the Examiner to point to the portions of Page or White which contain the teaching, suggestion, or motivation to combine these references as proposed by the Examiner. A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. Id. at 1434-35. Thus, the Office Action fails to provide proper motivation for combining the teachings of Page or White either individually or in combination.

The Applicants still further submit that the Office Action acknowledges, and the Applicants agree, that Page fails to disclose the emphasized limitations in dependent claims 5 and 18. Specifically the Examiner acknowledges that Page fails to teach the

plurality of acceptable native formats comprises Extensible Markup Language (XML), Electronic Data Interchange (EDI), and serialized object formats. The Examiner further acknowledges that Page fails to teach the internal format comprises serialized object format, the parameters being converted into serialized object classes by the selected translator. (2 August 2005 Office Action, Pages 12-13). However, the Examiner asserts that the cited portions of Cooper disclose the acknowledged shortcomings in Page. The Applicants respectfully traverse the Examiner's assertions regarding the subject matter disclosed in Cooper.

The Applicants further submit that Cooper has nothing to do with dependent claims 5 and 18 limitations regarding: (1) a request broker, implemented as a component within a hub system, having a plurality of acceptable native formats and (2) a translator for translation of the parameters from the native format to an internal format. Rather Cooper discloses a method to convert a programming language only through a static or dynamic process. (Abstract). Cooper does not disclose a request broker, implemented as a component within a hub system, having a plurality of acceptable native formats or a translator for translation of the parameters from the native format to an internal format. Thus, Cooper cannot provide a request broker, implemented as a component within a hub system, having a plurality of acceptable native formats or a translator for translation of the parameters from the native format to an internal format, since Cooper does not even provide for a request broker or even a application server system.

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Page or Cooper, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that it would have been obvious to one having ordinary skill in the art at the time of invention was made to incorporate Cooper into Page's service broker such that it would be useful to have a method for adapting well-known APIs in some manner for use as a Web-based page description language. (2 August 2005 Office Action, Page 13). The Applicants respectfully disagree.

The Applicants further submit that the purported advantage relied on by the Examiner for combining the references are nowhere disclosed, taught, or suggested in Page or Cooper either individually or in combination. The Applicants respectfully request the Examiner to point to the portions of Page or Cooper which contain the teaching, suggestion, or motivation to combine these references as proposed by the Examiner. A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. Id. at 1434-35. Thus, the Office Action fails to provide proper motivation for combining the teachings of Page or Cooper either individually or in combination.

The Applicants still further submit that the Office Action acknowledges, and the Applicants agree, that Page fails to disclose the emphasized limitations in dependent claims 8 and 21. Specifically the Examiner acknowledges that Page fails to teach the application server system supports one or more applications comprising at least a collaborative planning application operable to provide planning data for one or more clients within a supply chain. (2 August 2005 Office Action, Page 13). However, the Examiner asserts that the cited portions of Gervais disclose the acknowledged shortcomings in Page. The Applicants respectfully traverse the Examiner's assertions regarding the subject matter disclosed in Gervais.

The Applicants further submit that Gervais has nothing to do with dependent claims 8 and 21 limitations regarding an application server system operable to receive parameters from a request broker, implemented as a component within a hub system, and further operable to provide planning data for one or more clients within a supply chain. Rather Gervais discloses a portal that allows end users to access a server and view the users customized menu of applications. (Abstract). Gervais does not disclose an application server system, operable to receive the parameters from a request broker, implemented as a component within a hub system, comprising at least a collaborative

planning application operable to provide planning data for one or more clients, located remote from the hub system. Thus, Gervais cannot provide an application server system, since Gervais does not even provide for a request broker within a hub system, or even a collaborative planning application remote from the hub system.

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Page or Gervais, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that it would have been obvious to one having ordinary skill in the art at the time of invention was made to incorporate Gervais into Page's service broker such that it provides a common infrastructure for application administration, security management and directory use, which can help reduce information technology (IT) costs and speed solution deployment as taught by Gervais. (2 August 2005 Office Action, Page 14). The Applicants respectfully disagree.

The Applicants further submit that the reasoning relied on by the Examiner for combining the references are nowhere disclosed, taught, or suggested in Page or Gervais either individually or in combination. The Applicants respectfully request the Examiner to point to the portions of Page or Gervais which contain the teaching, suggestion, or motivation to combine these references as proposed by the Examiner. A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art <u>must be based upon a suggestion in the prior art</u>. In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. Id. at 1434-35. Thus, the Office Action fails to provide proper motivation for combining the teachings of Page or Gervais either individually or in combination.

The Applicants still further submit that the Office Action acknowledges, and the Applicants agree, that Page fails to disclose the emphasized limitations in dependent claims 9, 11, 12, 22, 24, and 25. Specifically the Examiner acknowledges that Page fails to teach: (1) a network application program interface request component and network application program interface reply component each comprise a version identifier indicating the version of the network application program interface request component and network application program interface reply component being used; (2) a network application program interface reply comprises a deprecation notice indicating to the client that the system application program interface method that was called should not be further used; and (3) the request broker further operable to generate a network application program interface exception component based on an exception occurring in connection with execution of a second system application program interface method called based on a network application program interface request component received from a second client, the network API exception component comprising a description of the second system application program interface method, a description of the exception, and a deprecation notice indicating to the second client that the second system application program interface method should not be further used. (2 August 2005 Office Action, Pages 14-15). However, the Examiner asserts that the cited portions of Lam disclose the acknowledged shortcomings in Page. The Applicants respectfully traverse the Examiner's assertions regarding the subject matter disclosed in Lam.

The Applicants further submit that Lam has nothing to do with dependent claims 9, 11, 12, 22, 24, and 25 limitations. Rather Lam discloses a component management application programming interface that provides a version of the server component management API and a reply indicating version incompatibility. (Abstract). Lam does not disclose: (1) a version identifier indicating the version of the network application program interface request component and a network application program interface reply component; (2) a network application program interface reply comprising a deprecation notice indicating to the client that the system application program interface method that was called should not be further used; and (3) the request broker further operable to generate a network application program interface exception component based on an

exception occurring in connection with execution of a second system application program interface method called based on a network application program interface request component received from a second client, the network API exception component comprising a description of the second system application program interface method, a description of the exception, and a deprecation notice indicating to the second client that the second system application program interface method should not be further used. Thus, Lam cannot provide: (1) a network application program interface request component and network application program interface reply component each comprise a version identifier indicating the version of the network application program interface request component and network application program interface reply component being used; (2) a network application program interface reply comprises a deprecation notice indicating to the client that the system application program interface method that was called should not be further used; and (3) the request broker further operable to generate a network application program interface exception component based on an exception occurring in connection with execution of a second system application program interface method called based on a network application program interface request component received from a second client, the network API exception component comprising a description of the second system application program interface method, a description of the exception, and a deprecation notice indicating to the second client that the second system application program interface method should not be further used, since Lam does not even provide for a version identifier indicating the version of the request component, a deprecation notice indicating the system application program interface method, and a request broker operable to generate an exception component.

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Page or Lam, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that it would have been obvious to one having ordinary skill in the art at the time of invention was made to incorporate Lam into Page's service broker such that the server component management application

programming interface reads a field in the message to determine whether an addressing format of the client computer is compatible with an addressing format of the server computer. The Office Action further states, that if the addressing formats are not compatible, the server component management application programming interface converts the message to an addressing format compatible with the server components. (2 August 2005 Office Action, Pages 15-16). The Applicants respectfully disagree.

The Applicants further submit that the reasoning relied on by the Examiner for combining the references are nowhere disclosed, taught, or suggested in Page or Lam either individually or in combination. The Applicants respectfully request the Examiner to point to the portions of Page or Lam which contain the teaching, suggestion, or motivation to combine these references as proposed by the Examiner. A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. Id. at 1434-35. Thus, the Office Action fails to provide proper motivation for combining the teachings of Page or Lam either individually or in combination.

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of Page, White, Cooper, Gervais and Lam, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a). A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior

<u>art</u>. In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. Id. at 1434-35. Thus, the Office Action fails to provide proper motivation for combining the teachings of Page, White, Cooper, Gervais, and Lam, either individually or in combination.

With respect to dependent claims 2, 5, 8, 9, 11, 12, 13, 15, 18, 21, 22, 24, 25, and 26; claims 2, 5, 8, 9, 11, 12, and 13 depend from amended independent claim 1 and claims 15, 18, 21, 22, 24, 25, and 26 depend from independent claim 14. As mentioned above, each of independent claims 1 and 14 are considered patentably distinguishable over the proposed combination of Page, White, Cooper, Gervais, and Lam for at least the reasons of depending from an allowable claim and are therefore considered to be in condition for allowance.

For at least the reasons set forth herein, the Applicants submit that claims 2, 13, 15, and 26 are not rendered obvious by the proposed combination of Page and White; claims 5 and 18 are not rendered obvious by the proposed combination of Page and Cooper; claims 8 and 21 are not rendered obvious by the proposed combination of Page and Gervais; and claims 9, 11, 12, 22, 24, and 25 are not rendered obvious by the proposed combination of Page and Lam. The Applicants further submit that claims 2, 5, 8, 9, 11, 12, 13, 15, 18, 21, 22, 24, 25, and 26 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of claims 2, 5, 8, 9, 11, 12, 13, 15, 18, 21, 22, 24, 25, and 26 under 35 U.S.C. § 103(a) be reconsidered and that claims 2, 5, 8, 9, 11, 12, 13, 15, 18, 21, 22, 24, 25, and 26 be allowed.

Furthermore, for at least the reasons set forth above, the Applicants respectfully request that the Finality of the present Office Action be reconsidered and that the Finality of the present Office Action be withdrawn.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there <u>must be some suggestion or motivation</u>, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) <u>must teach or suggest all the claim limitations</u>. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and <u>not based on applicant's disclosure</u>. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to <u>suggest</u> the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991; *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any

motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.
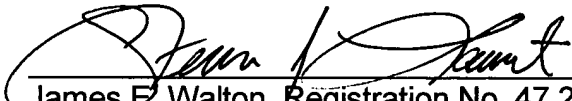
CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777.**

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

9/8/05

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